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PATENT
P56181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JU-HEON LEE

Serial No.: 09/685,138

Examiner: HUYNH, KIM

Filed: October 11, 2000

Art Unit: 2182

For: PORTABLE INTEGRATED CIRCUIT MEMORY DEVICE FOR USE WITH
UNIVERSAL SERIAL BUS3/10/04
K**PETITION UNDER 37 CFR §1.144**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction requirement (Paper No. 9) mailed July 8, 2003 and modified and made final in Paper No. 12 mailed October 29, 2003 in response to Applicants' request for withdrawal of the restriction requirement under 37 C.F.R. § 1.143 filed September 3, 2003.

Folio: P56181
Date: 2/18/04
I.D.: REB/ML

STATEMENT OF FACTS

1. Applicants filed a non-provisional patent application on October 11, 2000;
2. A first Office action on the merits (Paper No. 5) was mailed to Applicant on February 27, 2003 applying U.S. Patent No. 6,012,103 to Sartore *et al*, U.S. Patent No. 6,148,354 to Ban *et al* and U.S. Patent No. 6,079,019 to Fukuzumi *et al*.
3. Applicant responded to Paper No. 5 on May 19, 2003 by traversing the prior art rejections.
4. An election/restriction requirement (Paper No. 9) was mailed on July 8, 2003 restricting Applicant's invention to three groups and to six species for a total of 18 separate inventions.
5. On September 3, 2003, Applicant responded to Paper No. 9 by filing an amendment, provisionally electing Group III, specie 6 and by traversing the restriction/election requirements under 37 C.F.R. 1.143.
6. Another Office action on the merits (Paper No. 12) was mailed on October 29, 2003. In Paper No. 12, the Examiner modified the restriction requirement to have four groups and 6 species and then examined only claims 16-20 and 25-29 drawn to

Group II and species 6. In Paper No. 12, the Examiner rejected these 10 claims using U.S. Patent No. 6,317,836 to Goren and previously applied U.S. Patent No. 6,012,103 to Sartore *et al.* In Paper No. 12, the Examiner acknowledged Applicant's 37 C.F.R. 1.143 request for withdrawal of the restriction requirement filed on September 3, 2003 and the Examiner finalized the restriction / election requirement.

7. On February 10, 2004, Applicant Interview the Examiner in an attempt to resolve the restriction and election of species issues.

REMARKS

Applicant hereby petitions, under 37 C.F.R. 1.144 the finality of the restriction requirement and the election of species requirement of Paper No. 12 mailed October 29, 2003.

The following election/restriction requirement was made Final in Paper No. 12:

Group I, Claims 1-2, 4-11 and 21-24 drawn to a peripheral configuration of portable memory device, classified in class 710, subclass 8;

Group II, claims 16-20 and 25-30 drawn to the method of input/output access regulation, classified in class 710, subclass 36;

Group III, claim 31 links Groups I and II; and

Group IV, claim 32 linking Groups I and II.

Specie 1, Figs. 1A-1B, directed to a memory device with a hole;

Specie 2, Figs. 2A-2C, directed to the cover of the memory device;

Specie 3, Figs. 3, 4A and 4B, directed to the connection between a USB memory device and a USB supporting computer;

Specie 4, Fig. 5, directed to the circuit configuration of a USB memory device;

Specie 5, Fig. 6, directed to the operation steps of a USB memory device used as a portable memory medium; and

Specie 6, Fig. 7, directed to the operation steps of a USB memory device used as a security key.

1. Applicant hereby traverses the above election/restriction requirement for the following eight (8) reasons:

A. Paper Nos. 9 and 12 fails to comply with 37 C.F.R. 1.146

37 C.F.R. 1.146 mandates that an Election of Species requirement be made **in the first action on an application**. Applicant submits that the election of species requirement of Paper Nos. 9 and 12 comes after an action on the merits (Paper No. 5 mailed February 27, 2003). Because Paper Nos. 9 and 12 contain an election of species requirement, and because Paper Nos. 9 and 12 are not the first office action for this instant patent application, Applicant submits that the Examiner did not abide by 37 C.F.R. 1.146 by newly presenting the election and the restriction requirements for the first time in Paper No. 9 and then modified in Paper No. 12. Therefore, the election of species requirement and the restriction requirements of Paper Nos. 9 and 12 must be withdrawn.

B. Paper Nos. 9 and 12 fail to comply with 37 C.F.R. 1.146

37 C.F.R. 1.146 states that the examiner “may require restriction of the claims **to not more than a reasonable number of species**”. Applicant submits that the six species listed in Paper No. 12, together with the four groups, $4 \times 6 = 24$ which Applicant submits is an unreasonable number of species. Therefore, the election of species requirement of Paper No. 12 is obstructionistic, an abuse of power on the part of the Examiner, and does not comport with notions of compact prosecution.

C. No need for separate classification and thus no undue burden present

In Paper No. 12, the Examiner classified Group I claims to class 710, subclass 8 and Group II to class 710, subclass 36. Applicant has consulted the U.S. Patent Office Manual of Classification and has found the following: Class 710 is Electrical computers & digital data processing systems: input/output and subclass 8 is peripheral configuration: **means or steps** for assigning operating characteristics to a peripheral. Group II was classified in class 710, subclass 36. Subclass 36 is I/O access regulation: **means or steps** for controlling which of the peripherals may transfer data with which of the digital data processing systems or computers. Applicant submits that since each subclass is described as “**means or steps**”, this indicates that each of subclass 8 and 36 pertains to both method **and** apparatus. Because each of subclass 8 and 36 in class 710 pertains to both apparatus and method, Applicant submits that the Group I claims and the Group II claims do not necessarily need to fall in separate classifications. Because the Group I and the Group II claims do not fall into different classifications, there is no undue burden on the part of the Examiner to examine the apparatus claims of Group I and the method claims of Group II in a single examination. Because there is no undue burden because the field of search is coextensive, the restriction requirement of Paper No. 12 must be withdrawn.

D. Restriction requirement is inconsistent and discriminatory vis-a-vis Sartore ‘103

In the above restriction requirement, Group I claims are apparatus claims pertaining to the structure of the USB memory stick and Group II claims are method claims pertaining to a method using the USB memory stick. In Paper Nos. 5 and 12, the Examiner applied Sartore *et al.*, U.S.

Patent No. 6,012,103 to reject Applicant's claims. It is kindly noted that claim 1 of Sartore '103 is an apparatus claim of a system comprising a host computer and a peripheral device, claim 14 is a method claim claiming a method of configuring the host computer and peripheral device and claim 24 is an apparatus claim for the peripheral interface. The fact that all three of these different types of claims are in a single issued U.S. Patent applied by the Examiner is evidence that the method and the different apparatus claims were not restricted in Sartore '103 as the Examiner is now trying to do to Applicant in Paper Nos. 9 and 12. Since patents are presumed valid, and since Sartore '103 has both method and apparatus claims, Applicant submits that the imposition of the present restriction requirement and the present election of species requirement of Paper No. 12 on Applicant's claims is both inconsistent and discriminatory. Therefore, Applicant requests withdrawal of the above election and restriction requirements.

E. Paper No. 12 fails to comply with MPEP 806.03 because the Examiner is restricting a SINGLE EMBODIMENT of Applicant's claimed invention into many patent applications.

MPEP 806.03 forbids restriction or election of species where a single embodiment is disclosed. In Paper No. 12, the Examiner is separating the cover feature, the interface feature and the circuit configuration of the apparatus of the USB memory stick into different species. Applicant submits that the presence or absence of these features in a particular claim is not indicative of separate embodiments. Instead, the presence or absence of these features in certain claims is evidence of varying scope of the claims. Since requiring claims of varying scope describing a single embodiment to be split up into different patent applications is forbidden by MPEP 806.03, the

election of species requirement of Paper No. 12 must be withdrawn.

F. Examiner haphazardly misclassified Group I and Group II claims in Paper No. 12

Applicant further submits that Group I and Group II claims were haphazardly selected by the Examiner to justify the election and restriction requirements of Paper No. 12. Applicant has consulted the Manual of Patent Classification and has read and recited the description of Class 710, subclasses 8 and 36. After examining these descriptions of these classes and subclasses, Applicant submits that Applicant's claimed invention could not possibly belong to the class and subclasses selected by the Examiner in Paper No. 12. Because of the faulty classification in Paper No. 12, the restriction requirement and the election of species requirement based on these faulty and haphazard misclassifications and must be vacated.

In Paper No. 12, the Examiner deems that Group I or claims 1, 2, 4-11 and 21-24 are drawn to class 710, subclass 8. Applicant disagrees. According to the Manual for Patent Classification, subclass 8 of class 710 is **"means or steps for assigning operation characteristics to a peripheral"**. Applicant submits that Applicant's USB memory stick does not assign operating characteristics to a peripheral as is required for subclass 8 of class 710. Applicant's invention merely reads a password from a USB memory stick and compares the password read to a password stored in the computer and if the two passwords match, the computer may boot up. If the passwords do not match, an error message is displayed and the computer cannot boot up. This has nothing to do with assigning operation characteristics to a peripheral. Instead, Applicant submits that the classification

of subclass 8, of class 710 for claims 1, 2, 4-11 and 21-24 is haphazard and faulty.

Even worse, in Paper No. 12, the Examiner stated that Group II claims or claims 16-20 and 25-30 are drawn to class 710, subclass 36. According to the Manual for Patent Examination, subclass 36 of class 710 is defined as **“means or steps for controlling which of the peripherals may transfer data with which of the digital processing systems or computers”**. This implies the existence of more than one peripheral and more than one digital processing system or more than one computer. However, in Applicant’s invention, there is only one peripheral (the USB memory key) and one computer. Therefore, there can not be any controlling which peripheral transfers to which computer as required for subclass 36 of class 710. Therefore, Applicant submits that these classes and subclasses of Paper No. 12 were haphazardly and inappropriately chosen to justify a 24 way restriction/election requirement. Since the election/restriction requirement of Paper No. 12 is based on faulty assumptions and faulty reasoning, the election/restriction requirement of paper No. 12 must be vacated.

Applicant’s invention denies access to the entire computer and the USB memory stick if the passwords do not match. Since this invention is not adequately represented by class 710, subclasses 8 and 36, the classification and the restriction and election requirements based on this faulty classification are faulty. Because the Examiner did not correctly classify Applicant’s pending claims in Paper No. 12, the Examiner failed to show undue burden necessary to justify a restriction requirement. Therefore, the restriction requirement in Paper No. 12 must be withdrawn.

G. Paper No. 12 fails to comply with MPEP 806.04 (f)

MPEP 806.04 (f) requires that if claims are restricted to different species as was done in Paper No. 12, claims that claim one specie must not also claim another specie. Also, claims that claim the other specie must not claim the first specie (mutual exclusion) MPEP 806.04(f). Applicant submits that Applicant's claims are not mutually exclusive and therefore should not be subject to an election of species requirement. For example, claim 1 claims the cover which is specie 2 in addition to the USB interface (Specie 4) and depending claim 8 claims steps S36-S40 of FIG. 7 (specie 6). Because the features of species 2, 4 and 6 are in a single claim (claim 8 and claim 30 for example), the features of species 2, 4 and 6 are not mutually exclusive. Therefore, MPEP 806.04 (f) was not abided to in the election of species requirement of Paper No. 12. Therefore, the election of species requirement of Paper No. 12 is improper and must be withdrawn.

In Paper No. 12, the Examiner considered Applicant's independent claim 25 and its depending claims 26-29 to be part of Group II, specie 6. However, in paragraph 8 of Paper No. 12, the Examiner refused to examine depending claim 30 because the Examiner states that depending claim 30 is not from elected species 6. Applicant disagrees. Applicant submits that claim 30 depends from claim 29 which is from species 6. Applicant submits that it was inappropriate for the Examiner not to examine claim 30 because claim 30 is not drawn to the elected specie even though claim 30 depends from claim 29 which the Examiner deems to be drawn to elected specie 6. This separate classification of claim 29 from depending claim 30 also violates the mutually exclusiveness as required by MPEP 806.04 (f).

H. 37 C.F.R. 1.141 (a)

37 C.F.R. 1.141 (a) allows more than a single specie to be claimed in a single patent application. Therefore, the restriction and the election of species requirement in Paper No. 12 is unnecessary.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Withdrawal of the restriction requirement of Paper No. 12;
- B. Withdrawal of the election of species requirement of Paper No. 12;
- C. Withdrawal of the examination of Paper No. 12 and force the Examiner to examine all pending claims in a single, new non-final Office action;
- D. Insist that the Examiner adhere to the doctrine of compact prosecution instead of the doctrine of obstructionism as exhibited by the Examiner so far in the prosecution history of 09/685,138; and
- E. Grant such other and further relief as justice may require.

Respectfully submitted,



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